

5244-0052-2X DIV
RSID 1-154-9(DIV)

#21
S. Board
10/26/99

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

TETSURO MOTOYAMA

: GROUP ART UNIT: 2756

SERIAL NO: 08/738,461

:

FILED: OCTOBER 30, 1996

: EXAMINER: LUU, L.

FOR: METHOD AND SYSTEM FOR
DIAGNOSIS AND CONTROL OF
MACHINES USING CONNECTION
AND CONNECTIONLESS MODES
OF COMMUNICATION



SUPPLEMENTAL REPLY BRIEF

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SIR:

This Supplemental Reply Brief is responsive to the Examiner's Supplemental Answer mailed August 16, 1999.

On a procedural note, the Examiner has created a confusing issue as to the status of this application. As explained in MPEP §1208.03, 37 C.F.R. §1.93(b)(1) expressly prohibits a Supplemental Examiner's Answer, which the Examiner has issued. Neither the Rules nor the MPEP explain how an Applicant is to respond to a Supplemental Examiner's Answer as such a Supplemental Examiner's Answer is prohibited. However, it is clearly unfair for the Examiner to be permitted to submit a Supplemental Examiner's Answer without the possibility of the Applicant having an opportunity to reply thereto. Thus, this document is labeled as a Supplemental Reply Brief.

If the Board deems the Supplemental Examiner's Answer as being inappropriate and

treats the Supplemental Examiner's Answer as a reopening of prosecution, this document is to be considered as a request for reinstatement of the Appeal and also this document is to be treated as a Supplemental Appeal Brief as described in 37 C.F.R. §1.193(b)(2)(ii).

Turning now to the Supplemental Examiner Answer mailed on August 16, 1999, it is respectfully pointed out that:

(A) Applicant's arguments regarding Kraslavsky et al. as being directed to a high speed system for transmitting real-time or near-real-time status information appear to be mischaracterized by the Examiner. On page 2, lines 10-17, the Supplemental Examiner Answer states, "Obviously, Kraslavsky does not teach improving system speed by connecting the printer on LAN because a computer has a printer connected directly on the computer's parallel port provides the best real-time or near real time for status information compare[d] to printer connected on LAN." Applicant has not stated or implied that Kraslavsky et al. teaches "improving system speed," but has instead pointed out, on page 2, lines 8-13 of Applicant's Reply Brief, and on the top of Page 6 of the Appeal Brief, that it is evident that the purpose of Kraslavsky et al. is to enable a printer to transmit sufficient amounts of data to a LAN to enable the printer to be an effective and intelligent member of the network. Applicant also pointed out that in Kraslavsky et al. there is a desire to have a high-speed response or a near real-time response when determining status or control information (e.g., see col. 14, lines 37-48; see also col. 16, lines 10-11). Applicant has pointed out that modifying Kraslavsky et al. to operate using Internet electronic mail which may be quite slow would be contrary to the teachings of Kraslavsky et al..

(B) Applicant's arguments regarding the historical transmission of text between

human users appears to be mischaracterized by the Examiner. On page 2, last line to page 3, line 11 the Supplemental Examiner Answer states, "Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, or video transmission capabilities that can communicate compound message to each others using Internet electronic mail message format." However, the cited portions of Cohn et al. mention electronic mail, but only in the context of a user-to-user transmission of information. On pages 7 through 8 of the Appeal Brief, Applicant pointed out that there have developed ways to send binary information utilizing text encoding, but there is no prior art of record disclosing Internet electronic mail messages used outside of the context of messages which originate from a user and which are transmitted to a user. Applicant pointed out that Cohn et al. merely disclose an electronic mail message originating from a *user* and terminating at a *user* and neither disclose nor suggest the concept of transmitting information from sensors.

Applicant respectfully points out that, in col. 30, lines 55-67, Cohn et al. disclose a messaging system between people who subscribe to a closed system. The system described separates subscribers from non-subscribers, whereas a general Internet electronic mail system does not distinguish between subscribers and non-subscribers. Also, as recited in Claim 1 of Cohn et al., the user profiles in database storage are critical to the system of Cohn et al.. The system updates the user profile among the hubs that use the database for operation, as shown in Figure 10. The availability of the user profile seems to be a critical factor of the system of Cohn et al., whereas Internet electronic mail, in contrast, does not require keeping a user profile. The locations of the sender and destination are likely to be found in the last hierarchy of the DNS server. The DNS information at the lowest level is not replicated among the hubs

in the system as in Cohn et al. Normally, intermediate systems between the sender and the receiver do not have any information about the user nor have any need to store the user profile.

The Supplemental Examiner Answer states, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Internet electronic mail to transmit many different types of information including the type of information which is exchanged in Kraslavsky among various source and destination systems because it would allow any type of messages to be transferred globally between any devices." It is respectfully pointed out that there is no suggestion as to how one would accomplish "global transfer of any type of messages between any devices" using Internet electronic mail by combining the teachings of Kraslavsky et al. and Cohn et al., especially since Cohn et al. teaches transmitting user-to-user electronic mail, and *not* electronic mail "between any devices." Cohn et al. also does not suggest transmitting electronic mail on a near real-time basis, as Kraslavsky et al. would seem to require in order to combine the references. As Applicant has pointed out previously, modifying Kraslavsky et al. to operate using Internet electronic mail which may be quite slow would be contrary to the teachings of Kraslavsky et al.

(C) On page 3, line 12 to page 4, line 7 the Supplemental Examiner Answer appears to mischaracterize Applicant's arguments regarding the Office Action's statement that it would have been obvious to use the Internet electronic mail message of Cohn et al. in the system of Kraslavsky et al. "because it would allow message [sic messages] to be transferred globally between any devices" (see second paragraph, Office Action mailed on November 25, 1998). Applicant had pointed out that, in this statement, the Examiner appeared to be stating that because electronic mail messages operate *in accordance with a standard* which is implemented using a variety of hardware and software, the use of Internet electronic mail

would provide an advantage to Kraslavsky et al. In response to this apparent assertion on the part of the Examiner, Applicant further pointed out that Kraslavsky et al. already operate in accordance with well-known standards, still further pointing out that Kraslavsky et al. include the use of many different protocols including TCP/IP which already allows for global transfer between devices. The Examiner makes a blanket statement that "Internet electronic mail is TCP/IP standard for electronic mail service and this well known feature is clearly documented by Douglas E. Comer's book," which is further cited. Applicant respectfully points out that neither Applicant nor Kraslavsky et al. mention, suggest, or imply the use of Internet electronic mail in reference to col. 19, lines 1-4 of Kraslavsky et al. At the time the invention was made, one skilled in the art would not have been motivated to combine the teachings of Kraslavsky et al. regarding TCP/IP with, according to the Examiner, the "well known feature" of Internet electronic mail, for the reasons cited on pages 6-13 in the Appeal Brief.

Applicant maintains that the Examiner has shown *no motivation* to modify Kraslavsky et al. to use Internet electronic mail "because it would allow message [sic messages] to be transferred globally between any devices," as stated by the Office Action discussed previously. "Because there is no evidence in the record of a suggestion, teaching, or motivation to combine the prior art references asserted against the pending claims, the obviousness rejections" should be reversed. *In re Dembiczaik*, 50 USPQ2d 1614, 1620 (Fed. Cir. April 28, 1999).

(D) As to Applicant's arguments that a reference cannot be modified to destroy its purpose, the Examiner simply references points made in his sections (A) through (C) of the Supplemental Examiner Answer, and then recites boiler-plate obviousness discussion regarding combining Cohn et al.'s teaching into Kraslavsky et al.'s invention, without further

discussion. Please refer to pages 10-13 of the Appeal Brief for details of why the essential features of Kraslavsky et al. are destroyed by the Examiner's suggested modifications.

Kraslavsky et al. teach an interactive system (see, for example, col. 4, lines 3-14). The interactive system is critical to the remote control system of Kraslavsky et al. (see, for example, col. 21, lines 6-15). It is pointed out that there is no guarantee of interactivity in an electronic mail system, as a sender may send electronic mail out when the receiver is down. Additionally, the system of Kraslavsky et al. only responds to a command from the remote location, and there is no teaching of initiation of transmission of information to the remote location.

One of the requirements for the system of Kraslavsky et al. is the board and remote system to establish a direct connection. An exemplary list of the direct connection requirements is illustrated in FIG. 13, step S1309; FIG. 15, steps S1501, S1502; FIG. 16A, step S1606; FIG. 20, step S2003; FIG. 24, step S2403; and col. 18, lines 17-33 of Kraslavsky et al. Applicant points out that the system employs broadcast as a means to notify existence before establishing the direct communication as shown in FIG. 5B S13, FIG. 14 S1401, FIG. 16A S1603, S1604, FIG. 20 S2001, FIG. 24 S2401. In Internet electronic mail systems, there is no broadcasting to establish the communication between the sender and receiver of the message. TCP/IP may use ARP to get the MAC address. However, it is likely to be the MAC address of an intermediate station instead of the final destination.

Consequently, the reversal of each of the outstanding rejections is respectfully requested.

Last, full consideration and entry of the original Reply Brief filed on June 7, 1999 is respectfully requested.

Respectfully submitted,

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